

REMARKS

Applicants' claims 46-55 and 58-69 are pending. Applicants appreciate and thank the Examiner for finding claims 50, 51, 61, 62, 66 and 67 allowable other than due to formalities, which have been attended to through amendment herein.

Examiner has rejected claims 46, 48, 54 and 55 as being anticipated by Skee US 6,465,403 ("Skee") under 35 U.S.C. 102(e).

Examiner has rejected claims 47, 49, 52, 53, 58-60, 63-65, 68 and 69 as being obvious in view of Skee.

Applicants' have considered the Office Action dated December 8, 2006 and respectfully disagree that Skee is prior art that anticipates or renders obvious any of the claims of the present application.

ANTICIPATION BY SKEE

Regarding claim 46, Skee fails to disclose a composition that "consists essentially of" the claimed components because Skee discloses compositions "that contain one or more metal ion-free bases and a water-soluble metal ion-free silicate." *See*, Skee, col. 5, lines 28 – 31. This is an essential element to Skee by both the specification disclosure and, in fact, the compositions presented in Skee that do not contain water-soluble metal ion-free silicates are comparative to show corrosion to aluminum due to the lack of such component. *Id.* Table 1. The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original) (Prior art hydraulic fluid required a dispersant which appellants argued was excluded from claims limited to a functional fluid "consisting essentially of" certain components).

Therefore, according to Skee, the water-soluble metal ion-free silicate component is a basic and novel characteristic of its disclosed compositions and would not be an optional component and, as seen by the fact that each and every allowed claim of Skee requires "a water-soluble metal ion-free silicate", Skee does not anticipate claim 46, which does not include such component according to Skee.

Similarly, claims 48, 54 and 55 are all patentable over Skee, which teaches "a water-soluble metal ion-free silicate" as an essential element. *See*, Table 1, *inter alia*.

OBVIOUSNESS REJECTION IN VIEW OF SKEE

Examiner has rejected claims 47, 49, 52, 53, 58-60, 63-65, 68 and 69 as being obvious in view of Skee.

The U.S. Patent and Trademark Office (“PTO”) bears the burden of establishing a *prima facie* case of obviousness. *In re Bell*, 26 USPQ2d 1529 (Fed. Cir. 1993). To establish a *prima facie* case, the PTO must satisfy three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference teachings in the manner suggested by the PTO. *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). Second, the skilled artisan, in light of the teachings of the prior art, must have a reasonable expectation that the modification suggested by the PTO would be successful. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Finally, the prior art reference must teach or suggest each and every limitation of the claimed invention. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, not in the Applicant’s disclosure. *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991). If any one of these criteria is not met, *prima facie* obviousness is not established.

To establish a *prima facie* case of obviousness, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Skee, however, does not satisfy any of these three requirements, let alone all three requirement.

Skee teaches that the formulations it discloses would not be effective without the “water-soluble metal-ion free silicate” component. Accordingly, 47, 49, 52, 53, 58-60, 63-65, 68 and 69 are each patentable for the reasons stated for claims 46, 48, 54 and 55.

In addition, Skee does not teach that the addition of hydroxylamine of 13% or more renders the composition incompatible with copper. The Examiner states that “Skee teaches...about 1% to about 30% of hydroxylamine or hydroxylamine salts” which when combined with a solvent, base and water would be “incompatible” with copper. Moreover, the “about 1%” hydroxylamine taught in Skee was found to provide “incomplete” stripping results in the claimed compositions. Therefore, Skee clearly does not suggest the invention claim in 58-60,

63-65, 68 and 69, which show the unexpected results of the critical nature of the range of about 2 to 12 percent hydroxylamine in the claimed compositions. *See*, Specification paragraph 119 and Table 5. Moreover, the ranges cited by Examiner in Skee do not have an expectation of success. In fact, there is an expectation of lack of success if too little or too much hydroxylamine is used.

Accordingly, there is little question that claims 47, 49, 52, 53, 58-60, 63-65, 68 and 69 are not obvious in view of Skee.

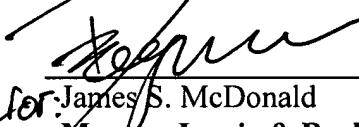
Conclusion

In light of the foregoing, Examiner's rejections have been obviated, leaving no impediment to the allowance of the present application.

If the Examiner believes a discussion of the above would be useful, he is invited to call the Applicant's attorney, James McDonald, at (212) 309-6719.

Respectfully submitted,

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